

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

REMARKS

The instant Amendment is filed in response to the official action dated August 15, 2003. Reconsideration is respectfully requested.

The disposition of the claims is as follows:

Claims 1-65 are currently pending.

Claims 1-13 are withdrawn from consideration.

Claims 14-50, 54-57, and 60-65 are allowed.

Claims 51-53, and 58-59 stand rejected.

Claim 51-53 have been amended.

The Examiner has rejected claims 51-53 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. As provided above, claims 51-53 have been amended to address the non-art concerns specifically identified by the Examiner. The Applicants believe that the areas of rejection have been identified and addressed in the foregoing amendment. Accordingly, it is respectfully submitted that claims 51-53 satisfy the requirements of 35 U.S.C. 112 and, as such, are in a condition for allowance.

-22-

WEINGARTEN, SCHURGIN,
GAGNEDIN & LEBOVICI LTD.
TEL. (617) 542-2290
FAX. (617) 451-0313

a

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

The Examiner has rejected claims 51 and 53 under 35 U.S.C. 102(b) as being anticipated by Connolly et al. (USP 5,644,295). Specifically, the official action indicates that the adhesion of the Connolly reference affects the destructibility of the security device by changing the adhesive properties between certain electronic components of the security device (see Fig. 3 of Connolly et al.).

However, the Applicants respectfully point out that amended claims 51 and 53 recite methods of modifying the destructibility properties of destructible tamper indicating tracks used in a tamper indicating transponder label, in which the modification involves (1) changing an adhesive used to apply a tamper indicating transponder label to an object or surface (see claim 51), or (2) changing the formulation of an adhesive modifying coating material (see claim 53). The notion of providing a tamper indicating transponder label, in which the destructibility properties of destructible tamper indicating tracks can be modified by changing an adhesive or by changing the formulation of an adhesive modifying coating material, is described throughout

a

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

the application, e.g., see page 6, line 22, page 27, lines 9-13, and page 50, lines 1-7, of the application.

In contrast, the Connolly reference discloses a security device including an electrically conductive strip disposed in a flexible body between a pair of contacts. An alarm apparatus is connected to the contacts to measure the resistance between them. In the event an attempt is made to lift the security device from an article to which it is applied, the circuit formed by the conductive strip can break and trigger the alarm (see column 1, lines 8-30, of Connolly et al.).

The Applicants respectfully submit that the security device disclosed in the Connolly reference is not a tamper indicating transponder label, as described and claimed in the instant application. The Connolly reference neither teaches nor suggests providing a tamper indicating label including a transponder, which is described in the instant application as an RFID transponder including an RFID memory chip and an antenna (see page 20, lines 19-23, of the application). Clearly, the electrically conductive strip connected to the alarm apparatus via the pair of contacts,

A

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

as described by Connolly et al., cannot be construed as an antenna of a transponder, as recited in claims 51 and 53.

Not only does the Connolly reference fail to give any hint about providing a tamper indicating transponder label, but it also fails to disclose modifying the destructibility properties of destructible tamper indicating tracks used in the tamper indicating transponder label by changing the adhesive used to apply the label to an object or surface, as recited in base claim 51. Instead, Connolly et al. merely disclose that the bond directly between the adhesive layer and the track is weaker than that directly between the track and the upper flexible member, but stronger than that directly between the release layer and the upper flexible member (see column 3, lines 40-44, of Connolly et al.). Contrary to the official action which indicates that the adhesion 8 affects the destructibility of the security device by changing the properties of the adhesion 8 between certain electronic components of the device (see page 4 of the official action), the Connolly reference merely discloses that the strength of the bonds between the various layers of the device are different. The Connolly reference does not disclose that the properties of the adhesion 8 are different between the various

-25-

WEINGARTEN, SCHURGIN,
GAGNICKIN & LEDOVICI LLP
TEL. (617) 542-2290
FAX. (617) 451-0313

BEST AVAILABLE COPY

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

layers of the device. Further, the Connolly reference does not disclose changing the adhesive used to apply the tamper indicating transponder label to an object or surface to modify the destructibility properties of the tamper indicating tracks, as recited in amended claim 51. Accordingly, the Applicants respectfully submit that the rejection of claim 51 under 35 U.S.C. 102(b) is unwarranted and should be withdrawn.

For at least the same reasons given for base claim 51, the Connolly reference fails to disclose modifying the destructibility properties of destructible tamper indicating tracks used in the tamper indicating transponder label by modifying the pattern of an adhesion modifying coating, as recited in base claim 53. In addition, the Applicants respectfully point out that "an adhesive" is different from "an adhesion modifying coating". These elements, "an adhesive" and "an adhesion modifying coating", are described throughout the instant application, e.g., see page 8, lines 4-5, which indicates that "the third layer 103 may be an adhesive layer, which in some embodiments is a pressure sensitive adhesive", and see page 9, line 27, to page 10, line 1, which indicates that "the destructibility of the tamper tracks 102 may be enhanced by including a thin layer of a suitable adhesion

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

modifying coating on the underside of the layer 101 (providing the RFID capability) either between the layer 101 and the tamper tracks 102, or between the tamper tracks 102 and the adhesive 103". Connolly et al. merely disclose the adhesion layer 8 - Connolly et al. disclose nothing about an adhesion modifying coating that may be employed to change the properties of the adhesion layer 8. Because Connolly et al. fail to disclose an adhesion modifying coating, the Connolly reference is silent about modifying the pattern of an adhesion modifying coating, as recited in amended claim 53. Accordingly, the Applicants respectfully submit that the rejection of claim 53 under 35 U.S.C. 102(b) is unwarranted and should be withdrawn.

The Examiner has further rejected claims 58-59 under 35 U.S.C. 102(b) as being anticipated by Lauro et al. (USP 5,604,485). Specifically, the official action indicates that the Lauro reference discloses several transponders disposed onto a single substrate, and that the transponders operate at several different frequencies. However, the Applicants respectfully submit that the Lauro reference fails to disclose anything about a flexible tamper indicating transponder having two or more transponders incorporated onto a single substrate, in which the

-27-

WEINGARTEN, RICHURGIN,
GAGNERIN & LEBOVITZ LLP
TEL. (617) 542-2280
FAX. (617) 451-0313

BEST AVAILABLE COPY

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

transponders operate at two or more frequencies or protocols, as recited in claims 58-59. It is well settled that for § 102 anticipation, a single reference must teach each and every element of the rejected claim. Because the cited Lauro reference neither teaches nor suggests providing a flexible transponder that is tamper indicating, the Lauro reference does not anticipate claims 58-59. Accordingly, the Applicants respectfully submit that the rejections of claims 58-59 under 35 U.S.C. 102(b) are unwarranted and should be withdrawn.

In view of the foregoing, it is respectfully submitted that the present application is in a condition for allowance. Early and favorable action is respectfully requested.

The Examiner is encouraged to telephone the undersigned Attorney to discuss any matter that would expedite allowance of

BEST AVAILABLE COPY

-28-

WEINGARTEN, SCHURGIN,
CAGNERIN & LSEBOVICI LLP
TELE. (617) 542-2290
FAX. (617) 451-0313

a

Application No. 09/915,760
Filed: July 26, 2001
TC Art Unit: 2636
Confirmation No.: 7473

the present application.

Respectfully submitted,

PETER S. ATHERTON, ET AL.

By:


Stanley M. Schurkin
Registration No. 20,979
Attorney for Applicants

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
Ten Post Office Square
Boston, MA 02109
Telephone: (617) 542-2290
Telecopier: (617) 451-0313

SMS/lkw
Enclosure
298413

BEST AVAILABLE COPY

-29-

WEINGARTEN, SCHURGIN,
GAGNEBIN & LEBOVICI LLP
TDL: (617) 542-2290
FAX: (617) 451-0313

a

WSGL WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP

Intellectual Property Law
Patents • Trademarks • Copyrights

Ten Post Office Square
Boston, Massachusetts 02109
Tel. 617.542.2290 • Fax. 617.451.0313
www.wsglip.com

*RECEIVED
CENTRAL FAX CENTER
NOV 17 2003*

OFFICIAL

FACSIMILE COVER SHEET

DATE: November 17, 2003

TO: Examiner Tweel
TC Art Unit: 2636

Fax No.: (703) 872-9314

FROM: Stanley M. Schurgin

No. of pages transmitted
(including this page): 31

Our File: PARP-129XX

Time:

Your Ref:

Sent by: Leigha

Application No. 09/915,760

Filed Date: July 26, 2001

A confirmation copy of this transmission will not be mailed unless the following is checked: []
MESSAGE

PLEASE DELIVER DIRECTLY TO:
EXAMINER TWEEL, Tel. (703) 308-7826
TC ART UNIT NO: 2636

FOR ENTRY/NOT FOR ENTRY

Enclosed for filing please find an: AMENDMENT

The Commissioner is hereby authorized to Charge Deposit Account No. 23-0804 for any additional filing fees associated with this communication or credit any overpayment.


 Attorney for Applicant: Stanley M. Schurgin
 Registration No. 20,979

THIS MESSAGE MAY CONTAIN CONFIDENTIAL OR PRIVILEGED INFORMATION INTENDED ONLY FOR THE PERSON(S) IDENTIFIED ABOVE. IF IT HAS BEEN RECEIVED AT ANY OTHER PLACE OR HAS NOT BEEN CLEARLY RECEIVED, PLEASE CALL THE ABOVE IDENTIFIED SENDING PARTY COLLECT FOR INSTRUCTIONS. DO NOT SHOW OR DISTRIBUTE THIS MESSAGE TO ANYONE OTHER THAN THE INTENDED RECIPIENT(S). THANK YOU.



Application No.: 09/915,760
 Filed: July 26, 2001
 TC Art Unit: 2636
 Confirmation No.: 7473

Rev 10/03

WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICH LLP
 Ten Post Office Square
 Boston, Massachusetts 02109
 Telephone: (617) 542-2290
 Telecopier: (617) 451-0313

Date: November 17, 2003

Via Facsimile
COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, VA 22313-1450

Attorney
Docket No.: PAPR-129XX

Sir:

In re application of: Peter S. Atherton, et al.

Entitled: MATERIALS AND CONSTRUCTION FOR A TAMPER INDICATING RADIO FREQUENCY IDENTIFICATION LABEL

Transmitted herewith is an amendment in the above-identified application. The following checked items are applicable:

- [] This is a Request for Continued Examination under §1.114; authorization is provided herewith to charge Deposit Account No. 23-0804 for the cost of same (\$ _____) per §1.17(e).
 [] Enter the unentered amendment previously filed on _____ per §1.116.
- [] A Petition for Extension of Time for ____ month is hereby made under §1.136(a); authorization is provided herewith to charge Deposit Account No. 23-0804 for the cost of same (\$ _____) per §1.17.
- [X] In the event a Petition for Extension of Time is required by this paper and not otherwise provided, such Petition is hereby made and authorization is provided herewith to charge Deposit Account No. 23-0804 for the cost of such extension.
- [] _____ is hereby appointed Associate Attorney by:
 Registration No.:

Attorney of Record:
 Registration No.:

[] Other:

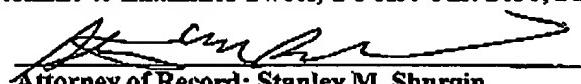
CLAIMS AFTER AMENDMENT:	MINUS PRIOR PAID CLAIMS:	EQUALS PRESENT EXTRA CLAIMS:	RATE:	ADDITIONAL FEE:
Independent	9 - 10	= 0	x \$86.00 =	0
Total	52 - 65	= 0	x \$18.00 =	0
[] Multiple Dependent Claims (1st presentation)		+ \$290.00 =		0
				0
				0
Small Entity filing, divide by 2. Small Entity status must be asserted.				0
				0

[X] No additional fee. [] The fee has been calculated above; authorization is provided herewith to charge Deposit Account No. 23-0804 (\$ _____) for the cost of same.

[X] The Commissioner is hereby authorized to charge payment of any additional filing fees under §1.16 associated with this communication or credit any overpayment to Deposit Account No. 23-0804.

I hereby certify that this correspondence is being sent via facsimile to Examiner Tweel, TC Art Unit 2636, Fax No. (703) 872-9314, on 11/17/03.

SUBMIT IN TRIPPLICATE
 298443


 Attorney of Record: Stanley M. Shurgin
 Registration No.: 20,979

